



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/372,474	08/11/1999	ELDON E. BAIRD	238/168	1434

7590

06/10/2002

Richard J. Warburg, Esq.
FOLEY & LARDNER
P.O. Box 80278
San Diego, CA 92138-0278

EXAMINER

MARSCHER, ARDIN H

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 06/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/372,474

Applicant(s)
Baird et al.

Examiner
Ardin Marschel

Art Unit
1631



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 5, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 38, and 42-49 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 38, and 42-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 25
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Due to the newly applied rejections herein summarized below, the finality of the office action, mailed 3/25/02, is hereby withdrawn. Applicants' amendment, filed 6/5/02, has been entered.

Applicants' arguments, filed 6/5/02, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. Upon reconsideration, the following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 1-5, 38, and 42-49 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 5, the parameter "M" is utilized but without being defined anywhere in the claim. Thus, this claim 1 and those dependent therefrom are vague and indefinite.

In claim 1, last two lines, the carboxamide residues are defined by their chemical names as utilized in the polyamide that is designed in the claimed method. The carboxamide residue given as "Hp", however, lacks such definition due to the apparently incomplete phrase "Hp is" in said last two lines. Thus, this claim 1 and those dependent therefrom are vague and indefinite.

Claim 49, line 1, indicates that the therein claimed polyamides are designed by the method of claim 1. Consideration of the polyamides as defined by the structure and parameters therein in claim 49 reveals that the structure defines polyamides that would not be designed via claim 1. One clear polyamide structure which does not come from a claim 1 design is the polyamide that is characterized by the parameter "a" being 0. It is noted that all polyamides designed in claim 1 contain a γ residue, but such a residue is present in the claim 49 structure only if parameter "a" is 1. Additionally, when parameter "a" in claim 49 is 1, the corresponding residue is a butyric acid type of residue if parameter "n" is 2. It is noted that the γ residue designed in claim 1 is a butyric acid type of residue and not another acid residue type. If parameter "n" is set to 1 in the structure of claim 49 then the residue therein is a propionic acid type of residue which is nowhere in the design of claim 1. Thus, claim 49 is vague and indefinite regarding indicating that the polyamides therein claimed are designed via the claim 1 design due to including polyamides where cannot be designed via the method of claim 1. A third unclarity exists in comparing claim 1 designs versus claim 49. In claim 1 there appears to be only one γ residue in each designed polyamide. In claim 49, the parameter "c" may be from 2 to 10. This parameter determines the number of residues in the "a" portion of the structure which

appears to be the γ residue number also. Thus, the polyamides of claim 49 with a γ residue therein (that is, $a = 1$) will have from 2 to 10 of γ residues therein. With 2 - 10 of these γ residues, none of the structures of claim 49 will have only 1 γ residue as designed in claim 1. Clarification is requested as to what is meant by this statement in claim 49, line 1, versus the structures therein compared to the polyamides designed in claim 1.

No claim is allowed.

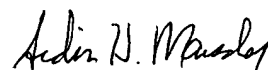
Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CAR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arden Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

June 7, 2002


ARDIN H. MARSCHEL
PRIMARY EXAMINER